

Remarks

Claims 1-2, 4-5, 7-10, and 13-24 are pending in this application.

I. Response to Rejections Under 35 U.S.C. § 103

A. Legal Standards Under 35 U.S.C. § 103

The legal standards for examination under Section 103 were reviewed in Applicants' Amendment under 37 C.F.R. 1.111 filed July 26, 2004, which are hereby incorporated by reference. Briefly, an applicant for a patent is entitled to the patent unless the application fails to meet the requirements established by law.

E.g., 35 U.S.C. §§ 102, 103. It is the PTO's duty to issue a patent or establish that the applicant is not entitled under the law to a patent. *In re Warner*, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Thus, the burden is on the PTO to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). If no *prima facie* case of obviousness is established, then a rejection under Section 103 cannot properly be sustained. *In re Oetiker*, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). To establish a *prima facie* case of obviousness, the PTO must show all of the limitations of the claimed invention in the prior art. *In re Ehrreich*, 200 U.S.P.Q. 504, 509-11 (C.C.P.A. 1979). The subject matter of the invention

must be considered as a whole and through the eyes of a hypothetical person of ordinary skill, not expert skill, in the relevant art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983). References must also be considered as a whole, including subject matter that teaches away from the invention as well as subject matter that suggests the invention, and not for their isolated teachings. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 227 U.S.P.Q. 657, 669 (Fed. Cir. 1985). References may be combined if there is a suggestion, motivation, or incentive in the prior art to make such a combination. *In re Dillon*, 16 U.S.P.Q.2d 1897, 1901 (Fed. Cir. 1990) (en banc); *In re Jones*, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992). It is not permissible to use hindsight to pick and choose among isolated teachings in the art after first having read Applicant's application to learn the pattern of the invention. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Finally, all the facts in evidence are evaluated, and patentability is determined on the totality of the record. *In re Corkill*, 226 USPQ 1005, 1008 (Fed. Cir. 1985). Factual determinations made by the PTO must be based on a preponderance of the evidence, and legal conclusions must be correct. *In re Caveny*, 226 USPQ 1, 3 (Fed. Cir. 1985).

B. Response to Rejection of Claims 1, 2, 4, 5, 7-10, and 13-24 over Australian Patent No. 9217076 in view of U.S. Patent No. 4,287,997

Claims 1, 2, 4, 5, 7-10, and 13-24 were rejected under 35 U.S.C. § 103(a) for allegedly being unpatentable over Australian Patent No. 9217076 ("Khoury") in view of U.S. Patent No. 4,287,997 ("Rolfe").

Khoury discloses a reusable plastic crate for use in holding agricultural produce, for example. The crate consists of a base to which are attached four sides by means of hinges. The sides can move between erect and "lie-flat" positions. Releasable attachments are disposed in adjacent sides for holding the sides erect. Such releasable attachments comprise a channel-shaped clip on the edge of one side and a flange on the adjacent side to fit in the channel. The flange may have a protruding rib, which fits in an aperture in the adjacent side. Adjacent sides may also have a top and bottom lug on one side to fit in openings in the other side.

Rolfe describes a container for shipping freight. The container is substantially cubic in shape, wherein the width and length are such that the container can be carried on a small- or medium-sized truck or trailer (column 1, lines 27-32). In one end of the container there is a doorway through which goods may be loaded or unloaded, this doorway normally being closed by a door

(column 1, lines 32-35). The end of the container containing the door is provided with connector means whereby the container may be releasably locked end to end to the corresponding end of a similar container such that the two doors are prevented from being opened (column 1, lines 35-39). The container is mounted on supports with longitudinal and transverse passages between them. These supports hold the container above ground level so that the arms of a fork lift can be engaged in the passages from either end or either side of the container (column 1, lines 39-44). On top of the container are situated locating members for interengagement with the supports of an upper container disposed thereon, such that the lateral and transverse passages are not obstructed. One of the locating members serves as a coaming (i.e., a raised border around an opening) for a hatch through which grain, for example, may be loaded into the container, and other locating members include means for connection to the hooks of a hoist (column 1, lines 44-53).

1. Claim 1

The Office Action alleged that "Khoury teaches a planter." This is incorrect. Khoury teaches a plastic crate for use in packing agricultural produce. The Random House Unabridged Dictionary 471 (2d. ed. 1993) defines "crate" as: "1. a slatted wooden box or framework for packing, shopping, or storing fruit,

furniture, glassware, crockery, etc. 2. any completely enclosed boxlike packing or shipping case."

The Office Action stated that Khoury is silent concerning flanges disposed on side walls. Applicants agree. However, the Office Action cited Rolfe as teaching a flange on the side wall of a "rectangular receptacle" for permitting attachment of "additional receptacles."

Rolfe shows a flange 31 and a channel 30 attached to a door 28 of a shipping container. When two such shipping containers are facing each other, they may be "releasably locked together" or "secured end to end" by means of the flange and channel for locking the doors. Rolfe fails to disclose or suggest securing or locking together of a third shipping container to two other containers. The likely reasons for this relates to the problems that Rolfe solves. Shipping containers are generally very large and, thus not well suited to transport by moderate-sized road transport. Rolfe's containers are smaller and better suited for such purpose. However, connecting more than two of Rolfe's containers runs into the same problem that large containers face, i.e., they are not well suited to transport by moderate-sized road transport. Further, a shipper of goods that are of insufficient volume to fill a large container must mix his good with those of another small-volume shipper to fill a large container. This results in delays

and lack of security for the goods. Rolfe solves this problem by providing smaller containers that, when connected in pairs, secure the doors from being opened. If a shipper wants to ship a large volume of goods, the shipper would use a large container, not connect more than two of Rolfe's smaller containers. For these reasons, Rolfe fails to disclose or suggest connecting more than two shipping containers. Thus, Rolfe, alone or in combination with Khoury, fails to disclose or suggest each and every limitation of the presently claimed invention.

Further, Rolfe is outside the scope of the prior art because it is nonanalogous art. *In re Deminski*, 230 USPQ 313, 315 (Fed. Cir. 1986), teaches a two-step process for determining whether art is analogous or nonanalogous. First, a determination is made if the reference is within the field of the inventor's endeavor. If it is not, then it is determined whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. The present inventors' endeavor is growing plants in planters. Rolfe relates to shipping of freight. Thus, Rolfe is not within the field of the present inventors' endeavor. The problems that Rolfe solves is increasing the security of the containers and shipping smaller volumes of freight. Two containers are connected end to end by means of their doors such that the doors are prevented from being opened. The present invention, on

the other hand, solves the problem of making a planter of a selected length by connecting any number of planters end to end to arrive at the selected, potentially infinite, length. A person of ordinary skill in the art of planters would not reasonably look to the art of freight containers to solve the problem of making planters of a selected length. Thus, freight container art is not reasonably pertinent to the present invention, and the Rolfe reference is nonanalogous art and, therefore, is not prior art.

Still further, even if Rolfe were prior art, which it is not, when Rolfe is considered in its entirety it suggests making enclosed cubic containers, which are inappropriate for use as planters. Rolfe further suggests providing passages for receiving the arms of a fork lift, which is also inappropriate for portable planters. Moreover, Rolfe suggests providing locating members on top of the containers for vertical stacking such containers, which is also inappropriate for planters of the type claimed in the present application. Thus, it is not clear what the combination of Khoury and Rolfe results in, but it is not the presently claimed invention.

"Those of ordinary skill in the art may be presumed to have knowledge of arts 'reasonably pertinent to the particular problem with which the inventor was involved.' *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). However, that prior art may

not be gathered with the claimed invention in mind. *In re Antle*, 444 F.2d 1168, 1171, 170 USPQ 285, 287 (CCPA 1971)." *Pentec, Inc.* v. *Graphic Controls Corp.*, 227 USPQ 766, 768-769 (Fed. Cir. 1985).

Applicants respectfully reiterate that Rolfe is not reasonably pertinent to the particular problem with which the present inventors were involved. Even if Rolfe were reasonably pertinent, what motivation is there to select Rolfe from among the freight container art patents, ignoring others, and make the combination with Khoury? There must be some motivation in the art, other than what is disclosed by the present patent application, to make such a combination. It appears that Rolfe was selected with the presently claimed invention in mind.

Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor. . . . [I]t is necessary to consider 'the reality of the circumstances', . . . -in other words, common sense-in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. . . . The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness.

In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443, 1445-1446 (Fed. Cir. 1992). Because it appears that Rolfe was selected with the

presently claimed invention in mind, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

For the reasons that (1) Khoury and Rolfe fail to disclose or suggest each and every element of the claimed invention, (2) Rolfe is nonanalogous art and is, thus, not prior art, (3) Rolfe was not considered in its entirety, and (4) there is no motivation to combine Rolfe with Khoury, other than the motivation found in Applicant's disclosure, a *prima facie* case of obviousness has not been established with respect to claim 1.

2. Claims 2, 4, and 5

Claims 2, 4, and 5 incorporate the subject matter of claim 1 by reference. Since a *prima facie* case of obviousness is lacking with respect to claim 1, it is also lacking with respect to all of the claims depending on claim 1.

3. Claims 7-10

The combination of Khoury and Rolfe, illegitimate as it is, fails to disclose or suggest forming a second cavity for growing plants adjacent to the first cavity. One reason for that is neither Khoury nor Rolfe relates to planters. Khoury discloses a fruit crate, and Rolfe discloses a freight container. The combination of Khoury and Rolfe fails to disclose or suggest each

and every limitation of the presently claimed invention. Rolfe is not prior art. Rolfe was not considered in its entirety. Motivation to combine Khoury and Rolfe is absent. Moreover, claims 7-10 incorporate by reference the subject matter of claim 1, for which no *prima facie* case of obviousness has been established. For these reasons, no *prima facie* case of obviousness has been established concerning claims 7-10, either.

4. Claim 13

Claim 13 incorporates the subject matter of claim 1 by reference. Since a *prima facie* case of obviousness is lacking with respect to claim 1, it is also lacking with respect to all of the claims depending on claim 1, including claim 13.

5. Claims 14 and 15

Claims 14 and 15 incorporate the subject matter of claim 1 by reference. Since a *prima facie* case of obviousness is lacking with respect to claim 1, it is also lacking with respect to all of the claims depending on claim 1, including claims 14 and 15.

Further, Claims 14 and 15 contain a limitation of a bracket disposed on the first front wall, first back wall, and first and second side walls. The Office Action alleged that Rolfe discloses such a bracket at reference number 30. First, Rolfe is not prior

art because it is nonanalogous art. Second, reference number 30 is a channel attached to a door. This channel is not attached to a first front wall, first back wall, and first and second side walls. Thus, Rolfe does not disclose or suggest each and every element what is claimed. Third, the combination of Khoury and Rolfe is illegitimate for lack of motivation to make the combination. Fourth, motivation to make the combination of Khoury and Rolfe is contained in Applicants' disclosure, on which it appears the Office Action relies in contravention of established Section 103 jurisprudence. For these reasons, no *prima facie* case of obviousness has been established for claims 14 and 15.

6. Claim 16

Claim 16 contains a limitation of first and second structures disposed on first and second side walls for facilitating attachment of additional front, backs, and bottoms, which are used for making additional cavities for holding plant growth medium. The combination of Khoury and Rolfe fails to disclose or suggest this limitation. As amply stated above, Rolfe is not prior art, nor was it considered in its entirety. Further, motivation for combining Khoury and Rolfe, other than the motivation disclosed in Applicants' specification, is not found in the prior art. For

these reasons, a *prima facie* case of obviousness has not been established concerning claim 16.

7. Claim 17

Claim 17 incorporates the subject matter of claim 16 by reference. Since a *prima facie* case of obviousness is lacking with respect to claim 16, it is also lacking with respect to all of the claims depending on claim 16, including claim 17.

Further, Claim 17 contains a limitation of a bracket disposed on the first front wall, first back wall, and first and second side walls, similar to what is described in claims 14 and 15. For the reasons set out above in the discussion relating to claims 14 and 15, no *prima facie* case of obviousness has been established for claim 17 with respect to the bracket limitation.

8. Claims 18-19

Claims 18 and 19 incorporate the subject matter of claim 16 by reference. Since a *prima facie* case of obviousness is lacking with respect to claim 16, it is also lacking with respect to all of the claims depending on claim 16, including claims 18 and 19.

9. Claims 20-21

Claims 20-21 incorporate the subject matter of claim 16 by reference. Since a *prima facie* case of obviousness is lacking with respect to claim 16, it is also lacking with respect to all of the claims depending on claim 16, including claim 20-21.

Claims 20-21 also claim the structures necessary to result in second and third cavities for holding plant growth medium, similar to what is claimed in claims 7 and 9. For the reasons set out above in the discussion of claims 7 and 9, a *prima facie* case of obviousness has not been established with respect to claims 20-21.

10. Claim 22

Claim 22 incorporates the subject matter of claim 16 by reference. Since a *prima facie* case of obviousness is lacking with respect to claim 16, it is also lacking with respect to all of the claims depending on claim 16, including claim 22.

Moreover, claim 22 contains the limitation of a flange, similar to what is claimed in claim 1. For the reasons set out above in the discussion of claim 1, a *prima facie* case of obviousness has not been established regarding claim 22.

11. Claim 23

Claim 23 contains a limitation of a bracket disposed on the first front wall, first back wall, and first and second side walls. The Office Action alleged that Rolfe discloses such a bracket at reference number 30. First, Rolfe is not prior art because it is nonanalogous art. Second, reference number 30 is a channel attached to a door. This channel is not attached to a first front wall, first back wall, and first and second side walls. Thus, Rolfe does not disclose or suggest each and every element of what is claimed. Third, the combination of Khoury and Rolfe is illegitimate for lack of motivation to make the combination. Fourth, motivation to make the combination of Khoury and Rolfe is contained in Applicants' disclosure, on which it appears the Office Action inappropriately relies. For these reasons, no *prima facie* case of obviousness has been established for claim 23.

12. Claim 24

Claim 24 incorporates the subject matter of claim 23 by reference. Since a *prima facie* case of obviousness is lacking with respect to claim 23, it is also lacking with respect to all of the claims depending on claim 23, namely claim 24.

Claim 24 also contains a flange, similar to what is claimed in claim 1. For the reasons set out above in the discussion of the

rejection of claim 1, a *prima facie* case of obviousness has not been established concerning claim 24.

C. The Obviousness Rejection Should Be Withdrawn

For the reasons described herein, it is respectfully submitted that a *prima facie* case of obviousness has not been established as to any of the claims currently under consideration. Hence, Applicants respectfully request that the rejection of all pending claims under 35 U.S.C. § 103(a) over Khoury in view of Rolfe be withdrawn.

II. Conclusion

Should the Examiner deem it advisable to conduct a telephone interview for any reason, the undersigned attorney would be most agreeable to receiving a telephone call to expedite the prosecution of the application.

For the reasons given above, Applicants respectfully request reconsideration and allowance of Claims 1, 2, 4, 5, 7-10, and 13-24 and passage of this application to issue.

Appl. No. 10/669,157
Amendment dated January 18, 2005
Reply to Office Action of October 18, 2004

DATED this 18th day of January, 2005.

Respectfully submitted,



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